

REMARKS

This application has been reviewed in light of the Office Action dated March 9, 2007. Claims 29 and 33-37 are presented for examination, of which Claims 29 and 33 are independent form. Claim 29 has been amended to define still more clearly what Applicant regards as his invention; new Claim 33 is a corresponding method claim. Claims 11, 17-19, 25-28 and 30-32 have been canceled without prejudice or disclaimer of subject matter. Dependent Claims 34-37 have been added to provide Applicant with a more complete scope of protection. Favorable reconsideration is requested.

Initially, Applicant notes that in the Office Action, the method claims and the independent program claim (Claims 19, 25-27, 31 and 32) were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

As to Claim 27, directed to a program stored in a computer-readable storage medium, the Office Action itself provides grounds for traversal of this rejection, in view of the Examiner's acknowledgment that "functional descriptive material may be claimed as a statutory product (i.e., a "manufacture") when embodied on a tangible computer readable medium ..." (page 3, middle of the page).

The rejection of the method claims was apparently based on the belief that those claims merely claim computer-program steps. There is of course no reason why the recited method steps need to be performed using programmed digital equipment, although that approach could be used, and the claims are not in step-plus-function format, so the Examiner is not justified in viewing the recited steps as being directed to the specific actions disclosed in the specification plus equivalents, which might support such a

rejection if only software implementations were disclosed. Accordingly, this aspect of the Section 101 rejection is also believed not to be well taken.

Nonetheless, solely to eliminate this as an issue and advance prosecution, and without in any way conceding the propriety of any of the rejections under Section 101, Applicant has canceled all of the claims rejected under that Section.

Claim 29 was rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 5,978,557 (Kato) in view of newly cited U.S. Patent 6,335,795 B1 (Neuhard et al.).

Claim 29 is directed to an image processing apparatus connected to a color printer and a monochromatic printer, and comprising discrimination means, determination means, output means and control means. The discrimination means discriminate whether each page in a print job is a color page or a monochromatic page. The determination means determine whether each page in the print job is to be output to the color printer or to the monochromatic printer based on the discrimination result, and the output means output print data of each page selectively to the color printer or to the monochromatic printer based on the determination result. The adding means add, to the outputted print data, an ejection command according to the color or monochromatic printer. The control means control each printer such that an ejection position is changed when a succeeding page is not serial to the previously outputted page based on the added ejection command.

Kato has been extensively discussed in previous papers, and it is not believed necessary to repeat that discussion. In any event, it is understood that the Examiner agrees with Applicant that *Kato* does not teach or suggest any structure in which the *system itself* changes ejection position in a given printer in response to a switch to that printer from outputting at another printer.

Neuhard relates to a system intended to ensure that the options selected by a user for a print job are available. The portions of *Neuhard* specifically cited by the Examiner relate to the user specifying a particular printer for use, for example, a color printer, or a monochrome printer, or specifying that portions of a job are to be printed in color or in monochrome, respectively. Applicant submits, however, that nothing has been found in *Neuhard* that appears to relate to the *system itself* changing ejection position in a given printer in response to a switch to that printer from outputting at another printer, as in the apparatus of Claim 29.

Moreover, any combination of *Kato* and *Neuhard* (assuming for argument's sake that such combination would be a permissible one) would still not teach or suggest adding, to print data, an ejection command according to the printer, and controlling the printer such that an ejection position is changed when a succeeding page is not serial to the previously outputted page, based on the added ejection command. Accordingly, Applicant submits that Claim 29 is allowable over any permissible combination (if any) of those two patents.

Independent Claim 33 is a method claim corresponding to apparatus Claim 29, and is believed to be patentable for at least the same reasons as discussed above in connection with Claim 29.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or the other of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

/Leonard P Diana/
Leonard P. Diana
Attorney for Applicant
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

FCHS_WS 1422882v1